



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,654	04/14/2004	Yoshio Terada	Q81096	4963
65565 7590 06/24/2008				
SUGHRUE-265550				
2100 PENNSYLVANIA AVE. NW				
WASHINGTON, DC 20037-3213				
EXAMINER				
DOUYON, LORNA M				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
06/24/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/823,654

Applicant(s)

TERADA ET AL.

Examiner

Lorna M. Douyon

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5, 8, 9 and 11-23 is/are pending in the application.
- 4a) Of the above claim(s) 11-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5, 8-9, 17-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. This action is responsive to the amendment filed on March 18, 2008.
2. Claims 5, 8-9, 11-23 are pending. Claims 6-7 and 10 are cancelled. Claims 11-16 are withdrawn from consideration as being drawn to a nonelected invention. Claims 17-23 are newly added.
3. The rejection of claims 1-4 under 35 U.S.C. 103(a) as being unpatentable over Suzuura et al. (US Patent No. 6,066,404) is withdrawn in view of Applicants' cancellation of these claims.
4. The rejection of claims 1-4 under 35 U.S.C. 103(a) as being unpatentable over Namikawa et al. (WO 01/94036) is withdrawn in view of Applicants' cancellation of these claims.
5. Claims 5, 8 and 9 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuura et al. (US Patent No. 6,066,404) for the reasons set forth in the previous office action.
6. Claims 5, 8-9, 17-19, 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Namikawa et al. (WO 01/94036), hereinafter "Namikawa".

Namikawa teaches a cleaning sheet for cleaning foreign matters away from the interior of the substrate processing equipment, and the cleaning sheet includes a

cleaning layer having layer substantially no tackiness and having a tensile modulus of not lower than 0.98 N/mm^2 (0.98 MPa), preferably from 0.98 to $4,900 \text{ N/mm}^2$ as determined according to JIS K7127 (see abstract; page 4, lines 3-6). The cleaning layer exhibits a 180° peel adhesion of not greater than 0.20 N/10 mm , preferably from 0.01 to 0.1 N/10 mm with respect to silicon wafer (see page 4, lines 13-15). The cleaning layer is not specifically limited in its material and structure so far as it has substantially no tackiness and one example, among a few, is polyimide (see page 5, lines 12-19). The cleaning sheet further comprises a base material for supporting a cleaning layer on one side thereof; and an ordinary adhesive layer provided on the other side of said base material (see claim 3). An ordinary adhesive (e.g., acrylic adhesive, rubber-based adhesive) may be used (see page 10, lines 6-13). Namikawa also teaches a polyester peelable film (see page 1, lines 12-15). Other equivalents of polyester peelable film include polypropylene (see page 5, lines 14-17). The cleaning sheet can be stuck to various substrates or other conveying members such as tape and sheet with an ordinary adhesive layer (see page 10, lines 14-19). Namikawa, however, fails to teach the relative intensities of the recited fragments ions in values as those recited, i.e. 0.1 or less.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to reasonably expect the relative intensities of the recited fragments ions in the cleaning sheet of Namikawa to be within those recited because the cleaning sheet of Namikawa uses ordinary adhesive such as acrylic adhesive which does not have any silicone components to yield the recited fragments ions.

7. Claims 20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Namikawa as applied to the above claims, and further in view of Terada et al. (WO 03/052045), hereinafter "Terada".

Namikawa teaches the features as described above. Namikawa, however, fails to disclose the protective film having been treated with a silicone-based release agent.

Terada, an analogous art, teaches a protective film release-treated with a silicone-based releasing agent laminated as a separator wherein the amount of silicone attached to said cleaning layer when the separator is peeled off said cleaning layer is 0.005 g/m^2 or less as calculated in terms of polydimethylsiloxane, and said protective film is used for protecting said cleaning layer when the interior of a device is cleaned to remove foreign matters attached thereto by conveying a conveying member such as sheet having a cleaning layer and substrate having such a sheet fixed into the device makes it possible to certainly prevent problems of contamination on the device due to separator and peel foreign matters simply and certainly without causing problems (see page 6, line 19 to page 7, line 9).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to treat the protective film of Namikawa with silicone-based releasing agent because this would protect the cleaning layer when the interior of a device is cleaned to remove foreign matters attached thereto as taught by Terada.

Applicant cannot rely upon the foreign priority papers to overcome this rejection (i.e., over WO 03/052045) because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Response to Arguments

8. Applicants' arguments filed March 18, 2008 have been fully considered but they are not persuasive.

With respect to the obviousness rejection based upon Suzuura, Applicants argue that claims 5 and 8 recite a "carrying member" and a cleaning sheet and a cleaning layer, and in the present invention, a carrying member is, for example, a semiconductor wafer, base for flat panel display (such as an LCD or PDP), or the base for a compact disc and MR head (see page 35, lines 1-7 of the specification), and that Suzuura does not disclose or suggest the use of a carrying member as recited in claims 5 and 8.

The Examiner respectfully disagrees with the above argument because, the present claims only require a "carrying member" and do not include a list of the carrying members as those recited above. As discussed in the previous office action, Suzuura teaches a support layer and carrying member which correspond to reference numeral 6 in Example 1, Figures 1 and 2, and also in Figure 4. Please note that claims must be given their broadest reasonable interpretation, see MPEP 2111.

With respect to the obviousness rejection based upon Namikawa, Applicants argue that Example 1 of the present specification uses a polypropylene film and

Art Unit: 1796

possesses the claimed relative intensities, while Comparative Example 1 uses a polyester film and does not. Applicants also argue that Comparative Example 1 is the closest example to the present invention because the only difference between Example 1 and Comparative Example 1 is the release film, and thus, Namikawa does not necessarily possess the claimed relative intensities, and one of ordinary skill in the art would not expect Namikawa to possess the claimed relative intensities.

The Examiner respectfully disagrees with the above arguments because the showing in Example 1 is not commensurate in scope with the present claims. The present claims require a cleaning layer comprising a polyimide resin, however, Example 1 uses a cleaning layer comprising a polyester film. Even assuming that Example 1 provides unexpected results when compared to Comparative Example 1, such showing is only limited to those specific components recited in Example 1, i.e., cleaning layer is polyester, and the releasable layer is polypropylene film. The present independent claims 5 and 8, however, require a polyimide resin as the cleaning layer and claim 5 requires a generic releasable protective film. Please also note that independent claim 8 does not require a releasable protective film. Therefore, the showing is not commensurate in scope with the present claims.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lorna M. Douyon whose telephone number is 571-272-1313. The examiner can normally be reached on Mondays-Fridays 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lorna M. Douyon/
Primary Examiner
Art Unit 1796